

Appl. No. 10/517,402
Amdt. Dated June 17, 2009
Reply to Office Action Mailed February 18, 2009

REMARKS

The above-identified application has been reviewed in light of the Notice of Non-Compliant Amendment mailed May 26, 2009, the Final Office Action mailed on February 18, 2009 and the Advisory Action mailed on April 29, 2009. By the present amendment, the Applicants have amended claims 21, 35 and 40, have added claims 48 and 49, and canceled claims 45-47. It is respectfully submitted that the claims pending in the application, namely claims 21, 23-28, 32-36, and 40-44, are fully supported by the specification, introduce no new matter, and are patentable over the cited references.

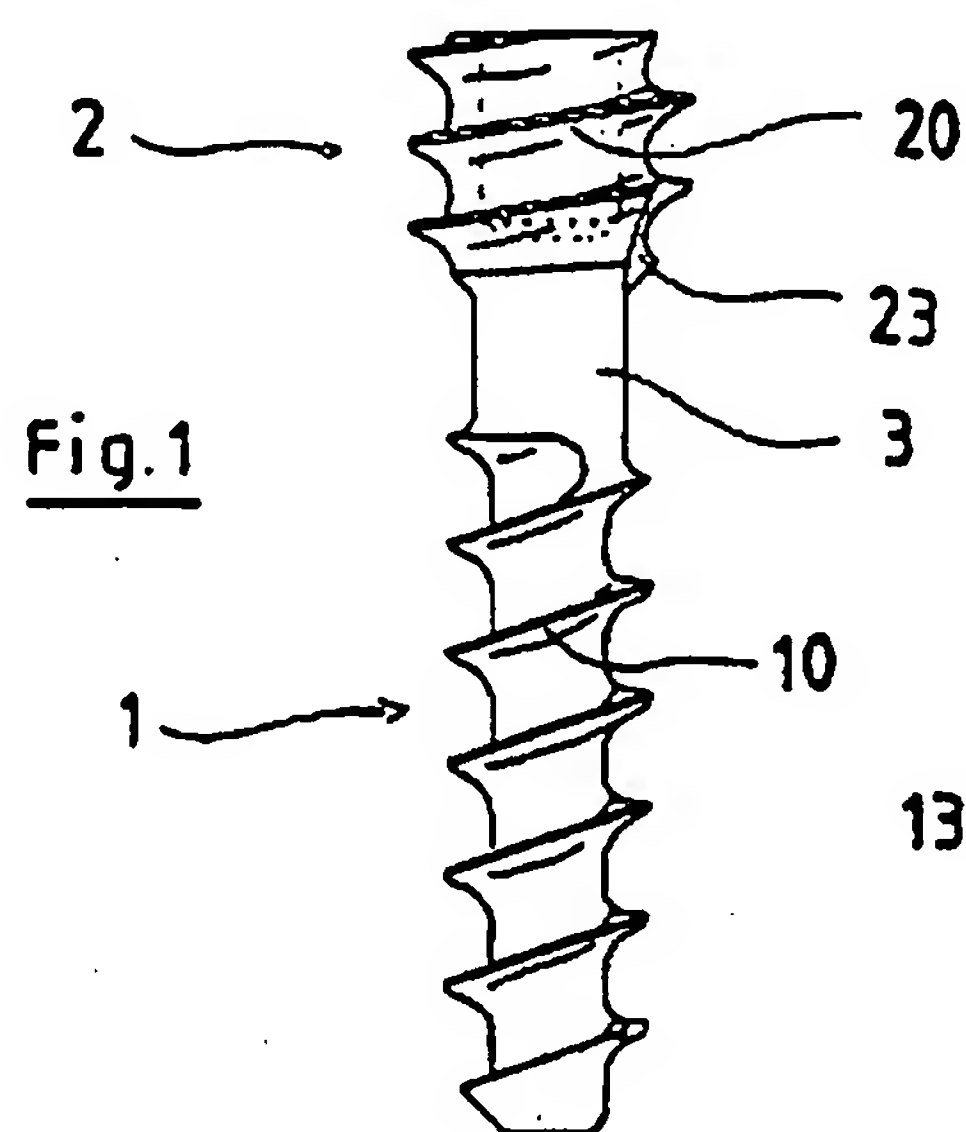
In the Notice of Non-Complaint Amendment, the Examiner found Claim 40 in the Listing of Claims to be identified with an incorrect status identifier. Instead of identifying Claim 40 appropriately as being "Currently amended", Claim 40 was identified as being "Previously presented". By the present amendment, the identifier of Claim 40 has been corrected to properly read that Claim 40 is "Currently amended." Accordingly, Applicants respectfully submit that the present amendment replaces the previously filed amendment and is fully response to the outstanding actions.

In the Office Action, claims 21, 23, 24, 27, 32-36 and 40-47 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,001,101 to Augagneur et al. (hereinafter "Augagneur"). The Office Action stated that Augagneur discloses a surgical tack with a head having a drive thread, a barrel portion having a tissue engaging thread, wherein a portion of the drive thread and a portion of the tissue engaging thread define a gap therebetween, the distal end of the drive thread and the proximal end of the tissue engaging thread being in the same plane that extends through a longitudinal axis of the barrel portion.

Claims 21, 35 and 40, as amended, recite a surgical tack for attaching a material to tissue

including, *inter alia*, a head having a drive thread formed on an outer surface thereof, the drive “thread forming an incomplete convolution of the head.”

As shown in Fig. 1, reproduced hereinbelow, Augagneur discloses a screw device having a long threaded distal part 1 and a short threaded proximal head part 2. Long threaded distal part 1 includes a first thread 10 and short threaded proximal head part 2 includes a second thread 20. Between distal part 1 and proximal part 2, the screw is provided with a smooth section 3. The screw operates to compress two bone fragments through the action of the differing pitches of thread portions 1 and 2. During a complete revolution of the screw about its longitudinal axis XX, the travel of distal part 1 is higher than the travel of proximal part 2.



Thus, since Augagneur specifically discloses that the screw operates by being rotated through at least a complete revolution to cause the compression of two bone fragments. In this manner, and as shown in Fig. 1, second thread 20 forms at least a complete convolution of the proximal part 2. Therefore, Augagneur fails to disclose or suggest a surgical tack including, *inter alia*, a head having a drive thread formed on an outer surface thereof, the drive “thread forming an

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incomplete convolution of the head”, as recited in amended claims 21, 35 and 40. Accordingly, it is respectfully submitted that the rejection of the Office Action has been overcome and that claims 21, 35 and 40 are in condition for allowance. Since claims 23, 24, 27, 32-34 depend from amended claim 21, claim 36 depends from claim 35, and 41- 44 depend from amended claim 40, it is respectfully submitted that these claims are also in condition for allowance. As noted above, by the present amendment, claims 45-47 have been cancelled.

In the Office Action, claims 25 and 28 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Augagneur in view of U.S. Patent No. 5,169,400 to Mühling et al. (hereinafter “Mühling”). The Office Action stated that Augagneur discloses a throughbore, but fails to disclose that the throughbore has a D-shaped cross-section. According to the Office Action, it would have been obvious to modify the throughbore of Augagneur to include a shape that better applies the torque of an insertion tool as disclosed in Mühling.

As discussed hereinabove, Augagneur fail to disclose or suggest the surgical tack recited in amended claim 21. Adding the non-circular throughbore of Mühling fails to cure the deficiencies of Augagneur. Mühling fails to disclose or suggest any features that, in combination with Augagneur, would suggest the surgical tack recited in amended claim 21. Since claims 25 and 28 depend from independent claim 21, it is respectfully submitted that these claims are in condition for allowance.

New claims 48 and 49 depend from claim 21. For at least the reasons stated above with respect to the patentability of claim 21, claims 48 and 49 are also patentable.

Please charge any deficiency as well as any other fee(s) which may become due under 37 C.F.R. § 1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s) to Deposit Account No. 21-0550. Also, in the event any extensions

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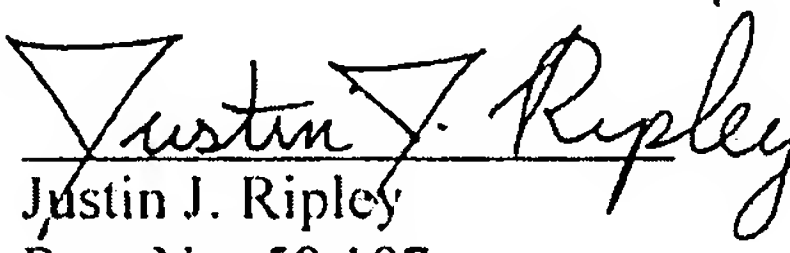
of time for responding are required for the pending application(s), please treat this paper as a petition to extend the time as required and charge Deposit Account No. 21-0550 therefor.

Prompt and favorable action on these claims, namely claims 21, 23-28, 32-36, 40-44, 48 and 49 is earnestly requested. Should the Examiner desire a further telephonic interview to resolve any outstanding matters, the Examiner is sincerely invited to contact the undersigned at (631) 501-5718.

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Respectfully submitted,


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